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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/100,671	06/19/1998	JEFFREY MARK ZUCKER	19010.715	8812
27683	7590	12/14/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/100,671

Applicant(s)

ZUCKER ET AL. 

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This office action is in response to amendment filed September 10, 2004. Claims 70-92 are pending.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant is claiming a CIP of application No. 08/784,829 (US 6,119,101) filed 1/17/1997, which claim provisional to 60/010087 filed 1/17/1996, and of 08/970,470 (US 6,286,002), filed 11/14/1997. However these applications do not include the claimed subject matter applicant is claiming in the instance application, therefore, cannot receive the benefit of the filing data of the parent cases (08/784,829) and 08/970,470 and also cannot receive the benefit of the provisional application (60/010,087). The parent cases do not disclose method and/or system of providing privacy through anonymity as disclosed in the instant application.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/057,685 and 60/052,373) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 70-92 of this

Art Unit: 3622

application. The provision applicants do not disclose method and/or system of providing privacy through anonymity as disclosed in the instant application. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/050,411) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 70-92 of this application. The provision applicants do not disclose "a payment key" in the manner used in the instant application.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/047,341) upon which priority is claimed have been filed more than a year before the instant applicant was filed. Thus could not claim the benefit of the filing data of the provisional application.

Applicant is required to amend the specification in order to properly claim the benefit of earlier filing date.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 70-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 recites, payment key associated with financial information, the financial information configured to include an identification of a financial institution, to include identifier for a pseudo credit account and to include pseudo expiration date for the pseudo credit account. Applicant's specification discloses "pseudo payment identity" or "pseudo payment type",

Art Unit: 3622

however does not disclose “payment key” associated with financial information that includes an identification of a financial institution and identifier for a pseudo credit account, to facilitate a purchase. In order for the Examiner to properly examine the claim, Applicant is required to clearly claim what he/she considers his/her invention. In light of the specification it not clear what is consider the “payment key”. Clarification is required. For the purpose of examining the claims Examiner considers the payment key as a “pseudo payment”, which could be a pseudo credit or debit or checking account in which the account is used for payment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 70-92 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gabber et al. U.S. Patent No. 5,961,593.

Art Unit: 3622

Regarding claims 70-72, 77, 78 and 80 Gabber teaches establishing a pseudo payment associated with financial information to facilitated purchase, wherein the pseudo payment includes pseudo credit account, pseudo expiration data; pseudo identity, providing the pseudo payment to seller and charging the real account of the user; establishing the pseudo identity at a privacy server; (see col. 8 lines 18-62, col. 10 lines 22-65, col. 11 line 54 to col. 13 line 53).

Regarding claims 73-75 Gabber teaches establishing pseudo identity at proxy different from the central proxy when the user might not trust the central proxy (see col. 13 lines 27-53).

Claims 87, 88, 90 and 91 are rejected as stated above in claims 70-72, 77 and 78.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 76, 79, 89 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Official Notice.

Regarding claims 76, 79, 89 and 92, Gabber does not explicitly teach single use of credit account and identifying two actual payment type and establishing at a rule set defining when to use the each of the payment type. Official notice is taken that is well known in the art of e-commerce to set rules to define the use of accounts. Financial institutions allow account for single transaction or limited transaction or for specific use or transaction. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to include such rules in order to minimize fraud or misuse of credit cards.

Art Unit: 3622

Claims 81-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Boies et al.

Regarding claim 81-86, Boies teaches arranging an entity for delivering a product to recipient for the seller and withholding from the seller information that would permit the seller to determine the actual identity of the buyer; generating a code; transferring the item based on the code... (see fig 2A-2C and col. 2 line 1 to col. 3 line 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Gabber's anonymous purchase with Boies's anonymous shipment system. One would be motivated to use Boies' shipping system for the purpose of providing a complete anonymity by protecting the identity of the buyer from the seller, as taught by Boies.

Response to Arguments

Applicant's arguments, filed September 10, 2004, with respect to "112, first paragraph" have been fully considered and are persuasive. The rejection of 112 has been withdrawn.

Applicant's arguments filed September 10, 2004, with respect to "112 second paragraph", "102" and "103" have been fully considered but they are not persuasive.

If the claim is too broad because it does not set forth that which applicant regard as their invention as evidenced by statements outside of the application as filed, rejection under 35 U.S.C 112, second paragraph, would be appropriate. If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under U.S.C 112, first paragraph would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C 102 or 103 would be appropriate.

Art Unit: 3622

Applicant in regard to the rejection of 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, provided more than two pages of definition for the term used in the claim (payment key). Applicant has to provide a “key” that is used in the manner claimed not just any key disclosed by applicant’s specification. The rejection of “112, second paragraph” is maintained.

As indicated above regarding “priority”, the instant applicant has an effective filing date of June 19, 1998 for the subject matter claimed in the instant application, therefore, both prior art are properly used for the rejection, as stated above under “102” and “103”, of the claimed subject matter. The Official Notice taken clearly state that it would have been obvious to ordinary skill in the art at the time of applicant’s invention was made to include such rule. Applicant has attempted to challenge the examiner’s taking of Official Notice on page 8 lines 1-5, however applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The examiner’s taking of Official Notice is maintained.

Applicant in his argument states that Gabber does not provide an enabling disclosure, Examiner disagrees. First of all Gabber’s patent is a patent which met the requirement of “112 enablement criteria” second Gabber teaches a system for which provides enablement for what is disclosed in the application, such as substitute identifiers, which include the features of anonymity. Applicant also argues that Gabber never mentions involving a financial institution with an alias credit card number thus does not provide an enabling disclosure of how any such

Art Unit: 3622

scheme could actually be implemented and even the involvement of a financial institution would not overcome the various problems that result from implementing the teaching in Gabber that the alias numbers would be generated in a somewhat random manner based on seed. Examiner would like to point out that the claim does not recite how the alias number is generated. Gabber teaches generating an alias credit card number and expiration data and then authenticate the data and sending it to a requesting site (seller site). The site then can collect the money form the proxy system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta
Primary Examiner
Art Unit 3622

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